

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Bang, et al.	§	Case: 2929D1/TCG/PMD/LE
	§	
Serial No.: 10/081,312	§	Filed: February 21, 2002
	§	
Examiner: Turocy, David P.	§	Group Art Unit: 1762
	§	
Confirmation No.: 6198	§	
	§	
Title: METHOD OF FORMING A	§	
CORROSION RESISTANT COATING	§	

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

REQUEST FOR RECONSIDERATION

Applicants respectfully request reconsideration of the Decision on Appeal mailed by the Board on July 31, 2007, for the reasons discussed below. This request is filed by the due date of August 31, 2007. Please charge any fee due for this request to Deposit Account No. 20-0782.

The Board affirmed the Examiner's decision to reject claims 1-12, 14-15 and 18-19 as obvious under 35 U.S.C. §103(a). Applicants have reviewed this decision and submit that the Board, citing *KRS Int'l Inc. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 82 USPQ 2d 1385, 1397 (2007), has unjustly based the decision by combining the prior art references like "pieces of a puzzle" when the requirement for a known predictable result of the combination as set forth by the Examiner and adopted by the Board is in error.

The holding in *KRS Int'l Inc. v. Teleflex* cited above requires that there must be a finite number of identified, predictable solutions which must lead to an anticipated success. In the references cited by the Examiner and Board, success could not have

been anticipated because the solutions alleged by the Examiner and adopted by the Board are of the Examiner's conclusion without factual underpinning by the cited references or established as known by one skilled in the art.

Particularly, the Board and Examiner erroneously conclude that *Itoh* recognizes that density in *Toyoda's* method would predictably increase by increasing temperature and decreasing pressure. However, the Board and Examiner fail to account for the fact that the electron beam deposition process of *Itoh* and sputter deposition process of *Toyoda* operate under fundamentally different physical principles. A skilled artisan would understand that a process parameter (such as pressure or temperature) an electron beam deposition process would not predictably produce the same or similar results in a sputter deposition process due to the disparate physical phenomena that drive each process.

Similarly, the Examiner's statement, adopted by the Board, that it would be obvious to use the combined temperature and pressure conditions respectively described in *Tomita* and *Morton* in a single deposition process is not support by evidence other than the Examiner's conjecture. *Tomita* is an evaporative process, while *Morton* is a physical vapor deposition (PVD) process. Since these two deposition processes are performed using fundamentally different deposition techniques, process equipment and process chemistries, the Examiners opinion that a process parameters from an evaporative deposition process would produce a predicable result a PVD process can not support the asserted combination when made without support from the references or other extrinsic evidence.

Moreover, the jump from *Ohashi's* teaching to avoid pin holes and defects to a conclusion that an increase in coating density is needed is clearly not found in *Ohashi*, other references of record or established as a known principle by one skilled in the art. Such correlation is solely the Examiner's opinion, and is not permissible as evidence of obviousness. See, *Brand and Capital Machine Co., Inc. et al. v. Miller et al.*, No. 2006-1419 (Fed Cir. May 14, 2007)


The Board and Examiner additionally conclude without supporting evidence that since *Toyoda* uses a target having a purity of 99.5%, then *Toyoda* teaches that the deposited film should have a high purity, and that one of ordinary skill would seek-out

appropriate process conditions to deposit such a magnesium fluoride film having a purity as high as possible. Here again it is only the Examiner's opinion that the mere presence of a target of a certain purity produces not only a corresponding purity of the deposited film, but motivation to seek a film with a purity as high as possible. Such correlation cannot be found in *Toyoda*, other references of record or established as a being known by one skilled in the art. Injection of the Examiner's opinion as evidence is not permissible. Moreover, without evidence that *Toyoda* produces such a high purity film, any process modifications cannot ensure a predictable result of a high purity film as claimed.

Thus, the Examiner and the Board fail base their conclusion of how the combination of the references would produce a predictable result on evidence provide by the references or established as being known to one skilled in the art. Applicants respectfully request reconsideration of the decision and reversal of the rejection of claims 1-12, 14-15 and 18-19.

Respectfully submitted,

Aug 31, 2007



Keith P. TABOADA
Attorney Reg. No. 45,150
(732) 530-9404

Patterson & Sheridan, LLP
595 Shrewsbury Avenue
Suite 100
Shrewsbury, NJ 07702